

REMARKS

This paper is filed in response to the office action mailed on July 6, 2005. In the office action, claims 1-17 stand rejected; in response claims 18 and 19 have been added and claims 1, 5, and 16 have been amended.

The amendments to claims 1 and 5 is a reduction in the members of the Markush group and therefore these amendments are supported by the specification and claims as filed. The amendment to claim 16 and new claims 18 and 19 are supported by paragraph nos. 0079-0085 of the specification as published or on page 14 of the specification as filed. No new matter is added thereby.

Turning to the rejections based upon the prior art, the Patent Office rejects claim 1 under 35 U.S.C. § 102(b) as allegedly being anticipated by Japanese Patent No. 02-182259 (“Yasushi”). In response, claim 1 has been amended and the elements of the Markush group for the wetting agent have been reduced to ether capped polyoxyalkylenes, ester capped polyoxyalkylenes, sorbitan esters, phosphatides, and alkyl amines. Yasushi cannot anticipate amended claim 1 because it does not teach or suggest any of the disclosed wetting agents. Instead, Yasushi merely discloses the broad genus—surfactants—while claim 1 requires specific wetting agents.

The fact that the specific wetting agents recited in amended claim 1 may be encompassed by the disclose genus in Yasushi does not render amended claim 1 anticipated or obvious. *In Re Baird*, 29 USPQ2d, 1550, 1552 (Fed. Cir. 1994) (the disclosure of a generic diphenol formula in a prior art reference does not render obvious a claim for a specific bisphenol A); *In Re Jones*, 21 USPQ2d, 1941, 1943 (Fed. Cir. 1992) (prior art reference disclosing a broad genus of salts does not render obvious a claim element to a specific salt). See also the cases cited at MPEP § 2132.02 at p. 2100-76 and § 2144.08.

Utilizing the guidelines set forth in § 2144.08, the broad genus “surfactant” covers thousands of different surfactants and wetting agents. There is no indication in Yasushi that one of ordinary skill in the art would have been motivated to suggest the specific elements of the Markush group of amended claim 1 and therefore amended claim 1 is not anticipated by nor rendered obvious by Yasushi.

Turning to the chart at § 2144.08 at p. 2100-155, the genus of surfactants is not small and the Markush group elements of amended claim 1 are in no way inherently disclosed by the genus “surfactant” of Yasushi. Further, Yasushi provides no express

teachings that would have motivated one of ordinary skill in the art to make the selections set forth in the Markush group of amended claim 1. Further, there is no teaching or structural similarity. With no other teaching to support the selections set forth in amended claim 1, claim 1 is clearly not anticipated and non-obvious in view of Yasushi.

Accordingly, applicant respectfully submits that the anticipation rejection based upon Yasushi is improper and should be withdrawn and further that Yasushi cannot be used as a base reference for an obviousness rejection either.

Next, the office action rejects claims 1, 4-5 and 8-13 under 35 U.S.C. § 102(b) as allegedly being anticipated by European Patent Application No. 0 568 334 ("Song"). In response, the Markush groups of claims 1 and 5 have been amended to traverse this rejection. Specifically, the Markush groups are now restricted to ether capped polyoxyalkylenes, ester capped polyoxyalkylenes, sorbitan esters, phosphatides, and alkyl amines.

In contrast, Song only teaches the use collagen, polyethylene glycol or glycerin as set forth in the office action on page 3. These three wetting agents do not encompass wetting agents of the Markush group of amended claims 1 and 5 and therefore the anticipation rejection of amended claims 1 and 5 is improper and must be withdrawn. Because amended claims 1 and 5 are not anticipated by Song, dependent claims 4 and 8-13 are not anticipated by Song as well.

Finally, the office action rejects claims 2-3, 6-7, 14 and 17 under 35 U.S.C. § 103 as being unpatentable over Song. However, Song fails to teach or suggest any one of the wetting agents of the Markush groups of amended claims 1 and 5 and therefore Song in no way teaches or suggests all of the claim limitations of amended claims 1 and 5 and therefore the obviousness rejection based upon Song fails to establish a *prima facie* case of obviousness under MPEP § 2142. Because independent claims 1 and 5 are not obvious in view of Song, dependent claims 2-3, 6-7, 14 and 17 are not obvious in view of Song. Accordingly, applicants respectfully submit that the obviousness rejection of claims 2-3, 6-7, 14 and 17 is improper and should be withdrawn.

Next, the office action rejects claims 15 and 16 as being obvious in view of Song in view of U.S. Patent No. 6,603,061 ("Armstrong").

The deficiencies of Song are addressed above. Armstrong is cited for the proposition that it teaches a kit. Armstrong in no way teaches or suggests the wetting agents of amended claim 1 or amended claim 16 and therefore no combination of Armstrong and

Song teaches or suggests all of the elements of claims 15 or 16 and therefore the obviousness rejection does not meet the standards MPEP § 2142. Accordingly, applicant respectfully requests that this obviousness rejection be withdrawn.

Claims 18 and 19 are narrower versions of amended claim 1 and 5 and therefore are also allowable over the art of record.

A check in the amount of \$400.00 to cover the fee for two additional independent claims is submitted herewith.

An early action indicating the allowability of this application is respectfully requested. A change of Power of Attorney and Revocation of Prior Powers is forthcoming. The undersigned verifies that he is authorized to act on behalf of the assignee of the present application.

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Respectfully submitted,

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